

REMARKS

This responds to the Office Action mailed on December 7, 2006.

Claims 1, 3, 9-13, 15, 19, 21-23, 25-26, 29 and 31-34 are amended, and claims 37-38 are canceled; as a result, claims 1-7, 9-19, 21-29 and 31-36 are now pending in this application.

§112 Rejection of the Claims

Claims 3, 7, 9-12, 19, 21-22, 25, 29, and 31-34 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Applicants have amended the claims as indicated above to address this rejection, and withdrawal of the rejection is respectfully requested.

§103 Rejection of the Claims

Claims 1-4, 7, 9, 13-16, 19, 21, 23-26, 29, 31, 35 and 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. (U.S. Publication No. 2003/0036964 A1) in view of Linden et al. (U.S. 6,266,649).

Claims 5-6, 17-18 and 27-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Linden et al. and further in view of Erdelyi (U.S. 6,631,522).

Claims 10, 22 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Linden et al. and further in view of Maze et al. (U.S. 6,216,264).

Claims 11-12 and 33-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Linden et al. and further in view of Ortega et al. (U.S. 6,144,958).

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyden et al. in view of Linden et al. and further in view of Bezos et al. (U.S. 6,029,141).

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness in connection with any of the above rejections for at least the following reasons:

- (1) Even if combined, the cited references fail to teach or suggest all of the elements of Applicants' claimed invention; and
- (2) The cited references are nonanalogous art.

We deal separately with each of these reasons below.

EVEN IF COMBINED, THE CITED REFERENCES FAIL TO TEACH OR SUGGEST ALL OF THE ELEMENTS OF APPLICANTS' CLAIMED INVENTION

The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 1 recites:

receiving listing identification data from a user;
searching a database of listing data to locate a plurality of similar listings;
receiving an indication from the user selecting a selected listing from the plurality of similar listings;
generating a proposed listing to present to the user, the proposed listing including listing data from the selected similar listing;

(Applicant's claim , Emphasis Added.)

The above-referenced Office Action concedes that "items are not similar listings (figs. 2A and 2B, page 4, col. left, lines 2-7; page 4, paragraph [0032], lines 1-9, paragraph [0036], lines 1-3)." The Office Action further acknowledges that Boyden provides no disclosure of a proposed listing that includes "the similar listing", nor of "receiving an indication from the user selecting the similar listing." (Office Action, pages 4-5).

The Office Action then goes on to contend that Lynden teaches "displaying similar item listings and a user selecting a corresponding hyperlink from a Webpage to obtain a listing of

recommended book titles or obtaining a listing of recommended music and video titles (fig. 6, col. 14, lines 15-20).”

Applicants acknowledge that Lynden does disclose a recommendation service that recommends items to individual users based on a set of items that are known to be of interest to the user. However Lynden does not cure the failure of Boyden to disclose that a proposed listing is generated for presentation to a user, this proposed listing including listing data from the selected similar listing. (Emphasis Added). Simply put, even combining the teachings of Boyden and Lynden, there is no disclosure of generating a proposed listing that includes listing data from a selected similar listing, the selected similar listing having been selected by a user from a plurality of similar listings located in a database of listing data.

The Office Action specifically states, when referencing Boyden, that “[t]he proposed listing does not include the similar listing” (Office Action, page 4, third paragraph), but then fails specifically to identify any teachings in Lynden to cure this deficiency in Boyden.

The fact that Lynden does not cure the identified deficiency in Boyden (i.e., the absence of a proposed listing including listing data from a selected similar listing) stands to reason when one considers that Lynden is not concerned with facilitating of generation of a listing (i.e., a seller-focused function), but is rather concerned with the generation of item recommendations (i.e., a buyer-focused function) based, for example, on current contents of a user’s shopping cart. Lynden would accordingly not disclose anything amounting to the generation of a proposed listing that includes listing data from a selected similar listing, and would accordingly not cure this identified deficiency in Boyden.

In conclusion, Applicants reaffirm the position that Lynden and Boyden, when combined, do not teach or suggest all of the claim elements of independent claim 1, and accordingly respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

THE CITED REFERENCES ARE NONANALOGOUS ART

Analogous art is all art that is either in the field of technology of the claimed invention or deals with the same problem solved by the claimed invention even though outside the field of technology. *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979).

The MPEP, at 2141.01(a) notes the following:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

As alluded to above, Lynden is concerned with generating recommendations of items to potential buyers, and accordingly discusses buyer-focused functionality. Boyden on the other hand, in the portions thereof relied upon in the Office Action, is concerned with seller-focused functionality. For this reason alone, Boyden and Lynden are non-analogous references, and a person of ordinary skill in the art, active in the field of seller-focused technologies (e.g., the

partial automation of the generation of listings) would for this reason not have considered Lynden because the subject matter of Lynden would not have commended itself to an inventor's attention in considering his or her problem.

For the reasons expressed above, the Applicants contend that Boyden and Lynden constitute non-analogous art, and request that the rejection under 35 U.S.C. § 103(a) of claim 1 be withdrawn.

The above presented reasons as to why the Office Action does not make out a *prima facie* case of obviousness in connection with claim 1 are of equal application to a consideration of the rejections under 35 U.S.C. § 103(a) of independent claims 13 and 23. It is accordingly further requested that the rejections against these independent claims also be withdrawn, for the reasons expressed above.

The remaining dependent claims of independent claims 1, 13 and 23 are deemed to include all elements (or limitations) of independent claims from which they depend, and the above provided reasons for the lack of a *prima facie* case of obviousness in connection with the independent claims are of equal applicability in refuting the rejections of their dependent claims under 35 U.S.C. § 103(a). The withdrawal of the rejections against these dependent claims is also respectfully requested.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/648,125

Filing Date: August 25, 2003

Title: METHOD AND SYSTEM TO GENERATE A LISTING IN A NETWORK-BASED COMMERCE SYSTEM

Page 14
Dkt: 2043.102US1

Respectfully submitted,


STEVE GROVE ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
408-278-4042

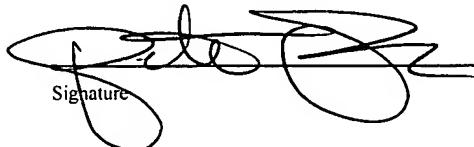
Date May 07, 2007

By /


Andre L. Marais
Reg. No. 48,095

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7 day of May 2007.

Peter Rehffoni
Name


Signature